

REMARKS

Claims 16, and 20-29 are currently pending in this application. By this Amendment, claims 16, 20, and 21 have been amended, claims 17, 18, and 19 have been cancelled, and new claims 22-29 have been added. The amended claim set is provided herewith.

Support for the amendments to claim 16 and new claims 24 and 28 can be found throughout the Applicant's specification (2004/0093053) and at paragraph 47, lines 1-3 and paragraph 53, lines 5-11. Support for newly added claims 23, 26, and 27 can be found throughout Applicant's specification and at figure 7 and the accompanying text at paragraphs 52 and 53. Support for newly added claims 22, 25, and 29 can be found throughout Applicant's specification and at paragraph 47, lines 1-3.

Applicant respectfully requests that this response should be entered because it presents the claims in condition for allowance.

Applicant requests a telephone interview with the Examiner regarding this application and this amendment in particular. Applicant invites the Examiner to contact Applicant's Representative, Anna Nelson, at 651-259-6702 or via email at anelson@cnwiplaw.com to schedule a time; alternatively, Applicant's Representative will contact the Examiner to schedule a time. Applicant thanks the Examiner in advance for his time.

Objection to the Claims

Applicant assumes that because this objection was not noted in the July 16, 2007 Final Office Action that it was overcome by the January 4, 2007 response.

Rejection of the Claims over Machek

Applicant assumes that because this rejection was not noted in the July 16, 2007 Final Office Action that it was overcome by the January 4, 2007 response.

Rejection of Claims over Brucker

Claims 16-19 and 21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Brucker et al. (U.S. Patent No. 5,643,197). Applicant respectfully traverses this rejection.

Although Applicant does not necessarily concede the correctness of this rejection, claim 16 has been amended. In order to anticipate a claim, the reference must disclose each and every

element of the claim. Applicant respectfully submits that Brucker fails to disclose at least one element of amended claim 16.

Claim 16 has been amended to specify that the medical lead comprises a ring-shaped electrode located distal to the mesh electrode, and said ring-shaped electrode is made of a solid surface material. The only structure of Brucker that is located distal to what is allegedly analogous to the mesh electrode (it should be noted that the Applicant has not and does not here concede that the elongated electrode 90 of Brucker is analogous to Applicant's mesh electrode) is the tip **26**. The tip **26** of Brucker is not made of a solid surface material and is instead porous. The summary of the invention evidences this by stating that "path means are formed within the tip structure for directing a fluid from the interior of the tip structure to portions of the tip structure **exterior** surface, thereby providing a fluid protective layer surrounding the tip structure" (Brucker, column 3, lines 27-31, emphasis added). The structure of tip **26** is further discussed at column 6 of Brucker, where it is stated that "tip structure **26** is preferably made of a sintered metal which contains a plurality of randomly formed through-passages or path means **48** in tip structure **26**." (Brucker, column 6, lines 1-4). As seen by the disclosure of Brucker, the tip **26** is a porous material that affords fluid communication between the central lumen **28** and the exterior surface **50** of the tip structure **26** (Brucker, column 6, lines 17-19). Because Brucker fails to disclose a lead that includes a ring-shaped electrode that is located distal the mesh electrode and is a solid surface material, it fails to disclose every element of claim 16, and therefore fails to anticipate claim 16. Applicant also notes that there may be other reasons why claim 16 is not anticipated by Brucker, and independent reasons why rejected claim 21 is not anticipated by Brucker; Applicant does not concede such arguments by having not presented them herein. Applicant therefore respectfully requests that this rejection be withdrawn.

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brucker. Applicant respectfully traverses this rejection.

Applicant will address this rejection as it applies to claim 16, and asserts that claim 16 is not obvious in view of Brucker. One of skill in the art, given the disclosure of Brucker would not have been motivated to modify the device of Brucker to construct the tip **26** as a solid surface material, because it would render the device of Brucker unusable for its intended purpose. According to MPEP § 2143.01(V), there can be no motivation to modify a reference if the proposed modification would render the device unusable for its intended purpose. The device of

Brucker is an ablation catheter that provides advances over the prior art by “forming a protective layer around the tip” by directing fluid flow from the central lumen of the device through the tip and onto the exterior of the tip. Making the tip of the device of Brucker of a solid surface material would not allow for such fluid flow from the central lumen to the exterior of the tip and would therefore change the way in which the device of Brucker functions.

Because there is no motivation to modify the device of Brucker, a *prima facie* case of obviousness cannot be made, and amended claim 16 cannot be rejected as obvious over Brucker. Applicant also notes that there may be other reasons why claim 16 is not obvious in view of Brucker, and independent reasons why rejected claim 20 and newly presented claims 22-29 are not obvious over Brucker; Applicant does not concede such arguments by having not presenting them herein. Applicant therefore respectfully requests that this rejection be withdrawn.

Rejection of Claims over Spreigl

Applicant assumes that because this rejection was not noted in the July 16, 2007 Final Office Action that it was overcome by the January 4, 2007 response.

Conclusion

In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 651.259.6702 or by e-mail at anelson@cnwiplaw.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 50-3964.

Respectfully submitted,

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